

Searches for these compounds are simple and strait forward. There should be no serious burden on the Examiner.

Additionally, the Patent and Trademark Office has, on numerous occasions, searched and examined compounds and intermediates, as well as bicyclic and tricyclic compounds together. For example, Applicant draws the Examiner's attention to claims 1 and 38 of U.S. Patent Number 5,932,553 (enclosed). This patent discloses tricyclic compounds of claim 1 that are useful as intermediates for preparing the bicyclic compounds recited in claim 38. See for Example column 14, lines 20-42 (enclosed), where the tricyclic compound HMAF is converted to the bicyclic compound 45. In the '553 application, claims to tricyclic compounds and bicyclic compounds were searched, examined, and allowed in one application. Thus, the action requested by Applicant is not without precedent.

On Page 4 of the instant Office Action, Paper number 12, the Examiner states that:

Inventions I and II-V are related as mutually exclusive species in an intermediate-final product relationship. Distinctnes is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04 (b), 3<sup>rd</sup> paragraph), and the species are patentably distinct (MPEP § 806.04 (h)). In the instant case, the intermediate product is deemed to be useful as herbicides, fungicides, bactericides, insecticides, etc., ..."

Applicants respectfully request evidence to be provided to show the utilities of the intermediates identified by the Examiner.

Finally, Claims 9-12 are each directed to a single compound. It is respectfully submitted that Applicant should not be required to incur the costs of four divisional filings in order to obtain protection for four compounds. Especially when claims 1-12 can readily be searched and examined together. In light of the above remarks, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement.

If the Examiner maintains the restriction requirement, Applicant requests that Group I (claims 1-6) and Group V (claim 12) should be examined together. The compounds recited by these claims possess a common tricyclic core ring system. Thus, the subject mater of these claims can be searched and examined without serious burden on the Examiner. M.P.E.P. § 803. Therefore, if the Examiner maintains the restriction requirement, Applicant requests that Group I (claims 1-6) and Group V (claim 12) be examined together.

The Reissue Oath or Declaration

The Examiner states that:

“The reissue oath or declaration filed on December 11, 2000 is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can based.”

The Examiner further states that:

“Office does not allow a reissue patent which does not correct any error in the original patent.

Applicant respectfully disagrees with the examiner's objection. In the Oath/Declaration dated December 6, 2001, Applicant specifically pointed out that:

“the error occurred due to the sole inventor, Arthor Romero, not fully understanding the metes and boundaries granted to the inventor by an U.S. patent. Dr. Romero believed, incorrectly, that if these compounds were specifically disclosed [but not claimed] in a patent application they were entitled to a patent protection. As a result, Dr. Romero did not request the then prosecuting attorney to claim these intermediates at the time of filing the original patent application. In fact, Dr. Romero never tried to claim these intermediates due to his incorrect belief. Since Dr. Romero did not communicate his understanding regarding these compounds to the then prosecuting attorney, the then prosecuting attorney did not, and was unable to, fully appreciate the full scope of the invention.”

Applicant wishes to remind the Examiner that there are number of court decisions pointing out that attorney's failure to appreciate full scope of invention is sufficient to satisfy error requirement of 35 USC 251. See *In re Wilder* 222 USPQ 369-373 (CAFC 1984). As such, applicant submit there are errors in the original patent. The errors which are relied upon to support the reissue application are errors upon which a reissue can based. Applicant further submits that the reissue oath/declaration filed on December 6, 2000 is not defective. Applicant respectfully requests that the Examiner reconsider her objection to the reissue oath/declaration and that it be withdrawn.

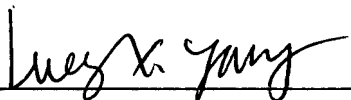
Lastly, the undersigned attorney wishes to address the Examiner's statement on page 2 of the Office Action dated Jan. 25, 2001. The Examiner states that:

"To clarify the record, there was never any formal interview of December 4, 2000 with the alleged attorney of record. The examiner NEVER AGREED that the filing of the present CPA, after two years from the grant of the original patent would have no impact on the applicants' right to file to enlarge the scope of the claims, that are subject of the instant reissue. This is a false and inaccurate allegation by applicants."

The undersigned attorney agrees that the phone conversation dated December 4, 2000 was not a formal interview. However, the phone conversion **did occur** on December 4, 2000. The undersigned attorney's solo purpose to call the Examiner was to confirm that because a CPA is entitled to the original reissue filing date, the CPA retains the right to enlarge the scope of the original claims. It was the only subject matter discussed during the phone conversion between the Examiner and the undersigned attorney; and the Examiner agreed with the undersigned attorney's understanding.

If the Examiner did not want the informal conversion put on the record, the undersigned attorney sincerely apologizes. On the other hand, the undersigned attorney wishes to be advised in advance when the discussion should not be referred to in writing. It appears to be common practice that Examiners and patent agents/attorneys put phone conversations on the record. For example, the undersigned attorney very often receives Examiners phone calls regarding restriction requirements or Examiners amendments. The Examiners would then later put the phone agreements on the record. Also very often, the undersigned attorney calls Examiners to seek advice regarding claim amendments and the advice is put on the record. In short, the undersigned attorney never intended to deceive the Examiner.

Respectfully submitted,

  
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Lucy X. Yang, Attorney  
Registration No. 40,259

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Pharmacia & Upjohn Company  
Global Intellectual Property  
301 Henrietta Street  
Kalamazoo, Michigan 49001

Telephone No. (616) 833-9536 or (616) 833-9500  
Telefax No. (616) 833-8897 or (616) 833-2316